

**REMARKS**

Reconsideration of this application, as presently amended, is respectfully requested. Claims 1, 3-5 and 7-9 are pending in this application, claim 6 having been cancelled by the present Amendment. Claims 1 and 3-9 stand rejected. The rejections set forth in the Office Action are respectfully traversed below.

Applicant would like to thank the Examiner for the courtesies extended to Applicant's representative during the telephonic interview conducted with the Examiner on December 15, 2005. During the course of the interview, the finality of the outstanding Office Action was discussed as well as the rejections of the claims in view of the prior art.

During the interview, the Examiner agreed that the current Office Action, which is a first Office Action after the filing of a Request for Continued Examination (RCE), was improperly made final. The Examiner indicated that he would consider the current Office Action to be a non-final Office Action. An official request for the withdrawal of the finality of the Office Action is set forth below.

Further, during the course of the interview, the rejection of independent claim 1 over the **Anderson et al. '918** reference was discussed. More specifically, the Examiner agreed that **Anderson et al. '918** does not disclose a device that displays a plurality of folder identification numbers and a count of a number of files managed by a selected folder on the same screen.

Finally, during the interview, the Examiner also noted that amending the claims to recite that the count of the number of image files and the folder identification numbers are displayed at the same time would even further patentably distinguish over the cited prior art.

**Request for Withdrawal of Finality of Office Action**

On page 8, Item 7 of the Office Action, the Examiner indicates that the first Office Action in the RCE has been made a final Office Action because “All claims are drawn to the same invention claimed in the application prior to entry of the submission under 37 C.F.R. 1.114 and could have been finally rejected on the grounds and art of record in the next Office Action if they had been entered in the application prior to entry under 37 C.F.R. 1.114,” citing the Manual of Patent Examining Procedure (MPEP) §706.07(b).

For the reasons set forth below, it is respectfully submitted that the Examiner has not satisfied the requirements set forth in the MPEP for making a first Office Action in an RCE a final Office Action.

First, claim 9 was rejected in the previous Office Action under §103 as being unpatentable over **Anderson et al.** Claim 9 is now rejected in the present Office Action under §103 as being unpatentable over **Anderson et al.** in view of **Kim et al.** Thus, it is clear that the requirement “all claims ....could have been finally rejected on the grounds **and art of record** in the next Office Action if they had been entered in the application prior to entry under 37 C.F.R. 1.114” has **not** been met. Specifically, the **Kim et al.** reference presently applied against claim 9 was not art of record. Therefore, it is submitted that claim 9 could not have been rejected over the art of record if entered in the application prior to entry under 37 C.F.R. §1.114.

Accordingly, it is submitted that the finality of the Office Action is improper and should be withdrawn for at least the above reason.

Second, MPEP §706.07(b) states “claims of a new application may be finally rejected in the first Office Action in those situations where... all claims of the new application (1) are drawn to the same invention claimed in the earlier application, **and** (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.” Thus, the requirement for final rejection in a first Office Action in an RCE is clearly conjunctive. That is, both conditions (1) and (2) must be met. It is respectfully submitted that all claims in the new application are not drawn to the same invention claimed in the earlier application. For example, claim 1 was amended to recite “a file number detector for detecting a count of the number of files managed by the folder holding...” and “a file number displayer for displaying the ~~number of files~~ count detected by ... .” It is respectfully submitted that detecting and displaying a *count* of the number of files managed by a folder is different from detecting and displaying a number of files managed by a folder. For example, displaying a number of files managed by a folder may encompass displaying a list of all files managed by that folder. Whereas, displaying a count of the number of files managed by a folder narrows the claim to indicate that a numerical indication (i.e., a count) of the number of folders is displayed.

Third, MPEP §706.07(b) requires that “all claims ....could have been finally rejected on the **grounds** and art of record in the next Office Action if they had been entered in the application prior to entry under 37 C.F.R. 1.114.” It is submitted that the claims could **not** been finally rejected over the same **grounds of record** if they had been entered in the application prior to entry under 37 C.F.R. 1.114. Specifically, it is submitted that the Examiner has changed the reasoning for the rejection of claim 1, and claims 3-9 which depend from claim 1, and therefore

the grounds of rejection has changed. Accordingly, it is submitted that the new reasoning for rejecting the claims constitutes new grounds of rejection.

It is respectfully submitted that the finality of the Office Action should be withdrawn for all the reasons set forth above.

**Claim Rejections – 35 U.S.C. §102 and 35 U.S.C. §103**

Claims 1 and 5-7 are rejected under 35 U.S.C. §102(b) as being anticipated by **Anderson et al.** (USP 5,861,918). Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over **Anderson et al.** (USP 5,861,918) in view of **Anderson et al.** (USP 6,507,363). Claims 3 and 4 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Anderson et al.** (USP 5,861,918) in view of **Inoue et al.** (USP 6,226,449). Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over **Anderson et al.** (USP 5,861,918) in view of **Kim et al.** (USP 6,496,361). For the reasons set forth in detail below, these rejections, to the extent that they are considered to apply to the amended claims, are respectfully traversed.

In the submission under 37 CFR §1.114, it was argued that **Anderson et al.** does not teach displaying a count of the number of files and folder identification numbers on the same screen. The Examiner responded by asserting “Referring to Fig. 7B in Anderson ‘918, the number of files (e.g., 8 files or items) and the folder numbers C1523460 are both displayed *on the same screen at the same time.*” See Office Action, page 3, lines 4-6.

Claims 1 and 5-7

For the reasons set forth in detail below, it is respectfully submitted that **Anderson et al.** '918 do not disclose or suggest that the count of the number of files and the folder identification numbers "are both displayed *on the same screen at the same time.*"

More specifically, as shown in the upper left corner of the display in Fig. 7B of **Anderson et al.** '918, the number of items (i.e., "8 items") in the *single* folder C1523460 is displayed.

However, independent claim 1 now clearly recites the *combination* of the following features "a folder number detector for detecting folder identification numbers which respectively represent the *folders* formed in said recording medium;" "a folder number displayer for displaying on a screen the *folder identification numbers* detected by said folder number detector;" and "a file number displayer for displaying the count detected by said file number detector on the screen on which the *folder identification numbers* are displayed by said folder number displayer, wherein the count of the number of image files and the folder identification numbers are displayed at the same time."

Thus, claim 1 clearly defines a screen on which the following are displayed: (1) a plurality of folder identification numbers (Note, claim 1 defines a "plurality of folders" formed on the recording medium. The "folder identification numbers represent the folders." Thus, a plurality of folder identification numbers are displayed.), along with (2) a count of the number of files managed by a folder holding a folder identification number selected by a selector. These features are shown, e.g., in Figs. 18 and 19 of the present application and described on page 13, line 14 and page 14, line 8.

In contrast to the present invention, according to **Anderson et al. '918**, a plurality of folders (C1523460, C9347825) are first displayed **without display** of a count of the number of files managed by a selected folder (see Fig. 7A). Then, after a folder is selected, a selected folder identification number is displayed (C1523460) along with image files managed by that folder and the number of items in the folder (see Figs. 7B and 7C).

However, as shown in Figs. 7B and 7C, only a *single* folder identification number is displayed with the count of the number of items in the folder. Unlike **Anderson et al. '918**, the claimed invention displays, at the same time, a *plurality* of folder identification numbers representing the plurality of folders formed in the recording medium *and* displays a count of the number of files managed by a selected folder on the screen on which the plurality of folder identification numbers are displayed.

Moreover, the claimed invention provides the advantage that a user can select the various folder identification numbers to determine the respective counts of the number of files managed by the various folders *without having to change the display screen* because the plurality of folder identification numbers are displayed for selection on the same screen and at the same time. In contrast, as can be seen from Figs. 7A-7C of **Anderson et al. '918**, if the screen shown in Fig. 7B were displayed for folder no. C1523460, and a user wanted to determine a count of the number of files in folder no. C9347825, the user would have to go back to the screen shown in Fig. 7A to select folder no. C9347825 in order to arrive at the screen shown in Fig. 7C.

A rejection under §102 requires that the prior art applied against the claims must teach each and every element recited in the claims. For the reasons set forth above, it is submitted that

**Anderson et al. '918** do not teach each and every element recited in claim 1, and therefore the rejection under §102 is improper and should be withdrawn.

Each of claims 5-7 depend from claim 1 and are allowable for the same reasons as claim 1.

#### Claims 3-4

Claims 3 and 4 were rejected over **Anderson et al. '918** in view of **Inoue et al.** The **Inoue et al.** reference was cited to teach displaying a total number of files. However, **Inoue et al.** do not alleviate the above-noted deficiencies of **Anderson et al. '918** discussed with respect to claim 1.

Because claims 3 and 4 depend from claim 1, claims 3 and 4 are allowable for the same reasons set forth above with respect to claim 1.

#### Claim 8

The Examiner applies **Anderson et al. '363** in combination with **Anderson et al. '918** to reject claim 8. Claim 8 is directed to an embodiment wherein a folder creator creates a new folder when writing to a designated folder is instructed in a state that the number of files managed by the designated folder indicates a predetermined value.

**Anderson et al. '363** teaches a system for automatically generating a plurality of folders for a digital camera that creates a new folder when it is detected that the current folder is full.

**Anderson et al. '363** suggests a full folder is a folder having 100 images (see. e.g., col. 7, lines 58-67 and Fig. 9, steps 464 and 456).

However, **Anderson et al. '363** does not alleviate the deficiencies of **Anderson et al. '918** discussed above with respect to claim 1. Therefore, claim 8, which depends from claim 1, distinguishes over the combination of **Anderson et al. '918** and **Anderson et al. '363** for the same reasons set forth above with respect to claim 1.

#### Claim 9

In rejecting claim 9 under §103 over **Anderson et al. '918** in view of **Kim et al.**, the Examiner recognizes that “Anderson is silent about a file mover for moving a file from a folder to another folder when a file moving operation is carried out, wherein the another folder is arbitrarily selected from among the plurality of folders formed in the recording medium.”

The Examiner relies on **Kim et al.** to teach the features missing from **Anderson et al. '918**. **Kim et al.** teaches a laptop computer having a video camera mounted in the lid.

However, it is submitted that claim 9, which depends from claim 1, is allowable for the same reasons as claim 1 because **Kim et al.** does not alleviate any of the deficiencies of **Anderson et al. '918** discussed above.

Further, it is submitted that there is no motivation or incentive to combine **Kim et al.** with **Anderson et al.** Specifically, although the **Kim et al.** reference teaches that the laptop computer uses a Windows 98 operating system, **Kim et al.** is silent with respect to any sort of file



management. Thus, it is respectfully submitted that the combination is the result of hindsight using applicants own teachings.

For the reasons set forth above, it is respectfully submitted that all pending claims patentably distinguish over the cited prior art. Reconsideration and withdrawal of the rejections under §102 and §103 are respectfully requested.

### **CONCLUSION**

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

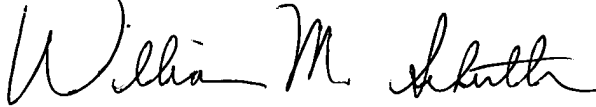
Application No. 09/873,413  
Group Art Unit: 2615

Amendment under 37 C.F.R. §1.116  
Attorney Docket No.: 010728

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, appearing to read "William M. Schertler", written in a cursive style.

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